



UNITED STATES PATENT AND TRADEMARK OFFICE

R-2001-138

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
WWW.USPTO.GOV

JAN 5 2001

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 C.F.R. § 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading her answers to questions 16, 27 and 34 of the morning section, and questions 28 and 33 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On July 17, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

**OPINION**

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded credit for morning question 19. Accordingly, petitioner has been granted one additional point on the Examination. However, no credit has been awarded for

morning questions 16, 27 and 34, and afternoon questions 28 and 33. Petitioner's arguments for these questions are addressed individually below.

Morning question 16 reads as follows:

16. A patent specification discloses a personal computer comprising a microprocessor and a random access memory. There is no disclosure in the specification of the minimum amount of storage for the random access memory. In the disclosed preferred embodiment, the microprocessor has a clock speed of 100-200 megahertz. Claims 9 and 10, presented below, are original claims in the application. Claim 11, presented below, was added by amendment after an Office action.

9. A personal computer comprising a microprocessor and a random access memory including at least 1 gigabyte of storage.

10. The personal computer of Claim 9, wherein the microprocessor has a clock speed of 100-200 megahertz.

11. The personal computer of Claim 10, wherein the random access memory is greater than ½ gigabyte of storage.

Which of the following statements is or are true about the respective claims under 35 U.S.C. § 112, fourth paragraph?

- (A) Claim 9 is a proper independent claim, and Claims 10 and 11 are proper dependent claims.
- (B) Claim 9 is a proper independent claim, and Claims 10 and 11 are improper dependent claims.
- (C) Claim 9 is an improper independent claim, and Claims 10 and 11 are improper dependent claims.
- (D) Claim 9 is an improper independent claim, and Claims 10 and 11 are proper dependent claims.
- (E) Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

The model answer is choice (E). Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

Petitioner argues that the most correct answer is choice (C). Petitioner argues that claim 9 is not supported in the specification and improper under the first paragraph of 35 U.S.C. 112.

Petitioner's arguments have been fully considered but they are not persuasive. Claims 9 and 10 are original claims in the application and constitute part of the original disclosure. Thus, they are self supporting, and satisfy the requirements of the first paragraph of 35 U.S.C. 112.

Choice (C) is incorrect and Choice (E) is correct. No error in grading has been shown.

Petitioner's request for credit on this question is denied.

Morning question 27 reads as follows:

27. On February 8, 1999, you filed a patent application that you prepared for Mr. Bond. The application contains only one claim. The application disclosed a composition having 20%A, 20%B, and either 60%C or 60%D. Claim 1 is as follows:

Claim 1. A composition useful for bonding semiconductor materials to metals, comprising 20%A, 20%B, and 60%C."

The examiner found a patent to Gold, dated March 8, 1998, which only disclosed and claimed a composition, having 20%A, 20%B, and 60%C, and also taught that the composition would only be useful for insulating metals from corrosion. The examiner rejected Claim 1 under 35 U.S.C. § 102(a) as anticipated by Gold, in an Office action dated August 9, 1999. Which of the following is most likely to overcome the rejection, and comports with proper PTO rules and procedure?

- (A) Filing a reply, on March 9, 2000, with a petition for a three-month extension and the fee for a three-month extension, traversing the rejection on the ground that Gold does not disclose using the composition for bonding semiconductor materials to metals, and therefore does not disclose all the elements of Claim 1.
- (B) Filing a reply, on September 9, 1999, traversing the rejection on the ground that Gold does not disclose using the composition for bonding semi-conductor materials to metals, and therefore does not disclose all the elements of Claim 1.
- (C) Filing a reply on October 9, 1999, amending Claim 1 to state as follows: "Claim 1. A composition comprising: 20%A, 20%B, and 60%D." In the reply, pointing out why the amendment gives the claim patentable novelty.
- (D) Filing a reply on October 9, 1999, traversing the rejection on the grounds that the patent to Gold teaches away from using the invention in the manner taught in Bond's application.

(E) Filing (i) a 37 C.F.R. § 1.132 affidavit objectively demonstrating the commercial success of the invention as claimed, and (ii) a reply containing an argument why the claimed invention is patentable, but no amendment to Claim 1.

The model answer is choice (C). The answer which comports with proper PTO rules and procedure and is most likely to overcome the rejection is to file a reply on October 9, 1999, amending Claim 1 to state as follows: "Claim 1. A composition comprising: 20%A, 20%B, and 60%D" and pointing out why the amendment gives the claim patentable novelty.

Petitioner argues that answer (D) is more correct than answer (C). Petitioner contends that answer (D) is most likely to overcome the rejection and afford the inventor greater latitude. Petitioner appears to argue that traversing the rejection on the grounds that the patent to Gold teaches away from using the invention in the manner taught in Bond's application would overcome the rejection under 35 U.S.C. 102(a).

Petitioner's arguments have been fully considered but they are not persuasive. Answer (C) is correct. See MPEP § 2111.02. (A), (B), and (D) are incorrect since the "use" recited in the preamble in Claim 1 does not result in a structural difference between the claimed invention and the disclosure in the Gold patent. Also see *In re Casey*, 370 F.2d 576 (CCPA 1967). (A) is further incorrect since the reply would not be filed within the statutory period. (D) is further incorrect since the rejection is not under 35 U.S.C. § 103, and any "teaching away" in the Gold patent is not applicable to the rejection under 35 U.S.C. § 102(a). (E) is incorrect since evidence of commercial success, relevant to secondary considerations concerning rejections under 35 U.S.C. § 103, is not relevant to overcoming rejections under 35 U.S.C. § 102(a). (C) is correct since the amendment is timely filed, supported by the disclosure, and renders the rejection under

35 U.S.C. § 102(a) inapplicable. Choice (D) is incorrect and Choice (C) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 34 reads as follows:

34. You have just received an Office action rejecting all of your claims in your patent application as anticipated under 35 U.S.C. § 102(a) using published declassified material as the reference. The examiner explains that the declassified material is being used as *prima facie* evidence of prior knowledge as of the printing date. The published declassified material contains information showing that it was printed six months before the filing date of the application, and that it was published two months after the application's filing date. You correctly note that although the printing date precedes your application filing date by six months, you note that the publication was classified as of its printing date (thus, available only for limited distribution even when the application was filed), and was not declassified until its publication date (when it became available to the general public). Each element of the claimed invention is described in the publication of the declassified material. Which of the following statements is true?

- (A) The rejection is not supported by the reference.
- (B) The publication is not available as a reference because it did not become available to the general public until after the filing date of your patent application.
- (C) The publication is *prima facie* evidence of prior knowledge even though it was available only for limited distribution as of its printing date.
- (D) The publication constitutes an absolute statutory bar.
- (E) It is not possible to use a Rule 131 affidavit or declaration to antedate the printing date of the publication.

The model answer is choice (C). The publication is *prima facie* evidence of prior knowledge even though it was available only for limited distribution as of its printing date.

Petitioner argues that choice (B) is also correct. Petitioner argues that answer (C) is not an absolute since MPEP 707.05(f) states that declassified material MAY BE taken as *prima facie* evidence. Petitioner further argues that "Answer B can also be construed as a TRUE statement."

Petitioner's arguments have been fully considered but they are not persuasive. The material is being applied under 35 U.S.C. 102(a) as *prima facie* evidence that the invention was "known

or used by others in this country” prior to the filing date of the application (i.e. as evidence of “prior knowledge”). MPEP 707.05(f) clearly points out that “declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time.” Petitioner’s emphasis on the phrase “may be” is misplaced since the statement of the question points out that “each element of the claimed invention is described in the publication of the declassified material.” Thus the publication clearly constitutes *prima facie* evidence of prior knowledge. Choice (B) is incorrect since the publication is available as a reference. Choice (C) is correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 28 reads as follows:

28. Which of the following is true?

- (A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.
- (B) The 2-month period for filing a petition mentioned in 37 CFR 1.181(f) is extendable under 37 CFR 1.136(a).
- (C) An examiner may enter a new ground of rejection in the examiner’s answer to an applicant’s appeal brief.
- (D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.
- (E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

The model answer is choice (E). When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent. See MPEP 1414 Content of Reissue Oath/Declaration and 37

CFR 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 CFR 1.63, including 1.63(c) relating to a claim for foreign priority.

Petitioner also argues that (B) is true because under 37 CFR 1.136, there is not an exception specified that relates to 37 CFR 1.181(f). Further, petitioner argues that 37 CFR 1.181(f) does not require that the petition be dismissed as untimely.

Petitioner's arguments have been fully considered but they are not persuasive. The two-month time period is not extendible under 1.136(a) since the time is within the discretion of the Commissioner. 37 CFR 1.181(f) provides that any petition under that rule which is not filed within 2 months from the action complained of may be dismissed as untimely. Choice (B) is incorrect and Choice (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:

33. A claim limitation reads "having 10 to 20 grams of iron, preferably 13-18 grams of iron." The specification preceding the claim supports not only the limitation, but also the broader amounts of iron. Which of the following statements is correct?

- (A) The limitation may be indefinite.
- (B) Since the limitation properly sets forth outer limits, it is definite.
- (C) As long as the limitation is supported in the written description, it is proper.
- (D) The limitation is definite since the limitation sets forth a preferred range.
- (E) The applicant, having set forth a limitation in the claim, i.e., a range of 10 to 20 grams, is precluded by the doctrine of equivalents from expanding the claim coverage beyond the 10 to 20 grams of iron.

The model answer is choice is (A). A limitation which reads "having 10 to 20 grams of iron, preferably 13-18 grams of iron" may be indefinite.



Petitioner selected answer (C). Petitioner argues that choice (C) is also correct because the claim is supported in the specification and is proper as to the written description requirement.

Petitioner's arguments have been fully considered but they are not persuasive. The claim limitation may be indefinite under 35 U.S.C. § 112, **second paragraph**. **MPEP § 2173.05(c)** indicates that a preferred narrower range set forth within a broader range may render the claim indefinite if the boundaries of the claim are not discernable. Choice (C) states that as long as the limitation is supported in the written description, it is proper. This is not true because the limitation is indefinite under 35 U.S.C. § 112, **second paragraph** even though it is supported in the specification. Choice (C) is incorrect and Choice (A) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

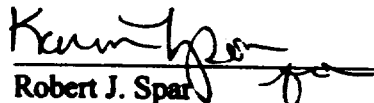
No error in grading has been shown as to morning questions 16, 27 and 34, and afternoon questions 28 and 33. Petitioner's request for credit on these questions is denied. The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr. Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.).

**ORDER**

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

  
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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy